

Remarks

Claims 20-25 are currently before the Examiner for consideration. Favorable consideration of the pending claims is respectfully requested.

Submitted herewith is a Request for Continued Examination (RCE) under 37 C.F.R. §1.114 for the subject application. Also submitted herewith is a supplemental Information Disclosure Statement (IDS), accompanied by the form PTO/SB/08 and copies of the references listed therein. The applicants respectfully request that the references listed on the form PTO/SB/08 be considered and made of record in the subject application.

As an initial matter, the applicants gratefully acknowledge the Examiner's indication that claim 21 is objected to but would be allowable if rewritten into independent form to include the limitations of any base and intervening claims.

Claims 20 and 22-25 have been rejected under 35 U.S.C. §103(a) as being obvious over Shchepinov *et al.* (Innovation and Perspectives in Solid Phase Synthesis, Int. Symposium, 1999) or Berlin *et al.* (*Org. Mass Spectr.*, 1969, 2:447-466). The applicants respectfully submit that the claimed set of calibration compounds are not obvious in view of the cited references.

The Office Action does not establish a *prima facie* case of obviousness. Neither the Shchepinov *et al.* abstract nor the Berlin *et al.* abstract teach or suggest using trityl compounds as calibration material in a mass spectrometry procedure. Further, the Office Action acknowledges that the Shchepinov *et al.* and Berlin *et al.* abstracts do not teach separately packaged mixtures of compounds (see page 3, line 14 of the Office Action). Claim 20 recites that mixture (a) and mixture (b) have molecular masses extending across different ranges. The cited references do not teach or suggest the separately packaged mixtures (a) and (b), having molecular masses extending across different ranges, as recited in claim 20.

The Office Action indicates that one of ordinary skill in the art would package trityl mixtures in the manner defined by claim 20 for the purposes of transportation, "with the number of packages optimized for transportation". The applicants respectfully submit that this conclusion is based on impermissible hindsight analysis of the prior art. An objective reading of the cited references does not suggest a set of compounds packaged as defined by current claim 20. There is no objective

reason presented in the Office Action as to why, after reading the cited references, one of ordinary skill in the art would produce a set of compounds comprising at least two mixtures with molecular masses extending across different ranges, each mixture containing at least two different trityl compounds. Claim 20 recites a specific combination of compounds that is not suggested by the prior art.

To establish a *prima facie* case of obviousness, three basic criteria must be met. The prior art must teach or suggest all the claim limitations. There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Finally, there must be a reasonable expectation of success. MPEP 2143. Thus, to establish a *prima facie* case of obviousness based on a combination of the content of various references, there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant. *In re Raynes*, 7 F.3d 1037, 1039; 28 USPQ2d 1630, 1631 (Fed. Cir. 1993); *In re Oetiker*, 977 F.2d 1443, 1445; 24 USPQ2d 1443, 1445 (Fed. Cir. 1992); *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Obviousness cannot be established by hindsight combination to produce the claimed invention. *In re Gorman*, 933 F.2d 982, 986; 18 USPQ2d 1885, 1888 (Fed. Cir. 1991).

Although it is possible that one of ordinary skill in the art could produce a specific combination of compounds such as the set of compounds now claimed, there is no objective reason presented in the Office Action as to why one of ordinary skill in the art would choose the particular arrangement defined by claim 20. There are many different ways that a compound can be packaged and there is no reason why one skilled in the art, upon reading the cited references, would choose the specific combination of trityl compounds recited by claim 20. The cited references do not suggest that trityl compounds can be used as calibration compounds and, therefore, the skilled person is given no motivation to consider using trityl compounds to provide the defined mixtures. Moreover, even if transportation of trityl compounds was envisioned by one of ordinary skill in the art, there would be no reason to provide the defined mixtures; rather, it would be desirable to maintain the compounds separately, in individual containers and not to mix different compounds together. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d

680, 16 USPQ2d 1430 (Fed. Cir. 1990), MPEP 2143.01 III. The initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventors have done. MPEP 2142.

The Office Action indicates that claim 21 is allowable and hence non-obviousness; therefore, the Examiner accepts that there is no suggestion in the cited references to package the compounds in the way recited in the claim. The Examiner's rationale as to the allowability of claim 21, on lines 6-9 of section 7 of the Office Action, indicates that it is not obvious to package compounds having the defined relationship between the molecular masses of the compounds in different packages. This reasoning can be applied equally to the subject matter of claim 20, as there is no reason why, based on an objective reading of the cited references, one of ordinary skill in the art would prepare the recited set of compounds comprising separately packaged mixtures (a) and (b) wherein the two mixtures have molecular masses extending across different ranges.

The set of compounds recited in claim 20 is advantageous over the prior art because the compounds have accurate predetermined masses, fly well in the mass spectrometer, do not break down and create noise, and are straightforward and inexpensive to produce. The specific arrangement of the compounds that is recited in claim 20 provides an elegant, effective calibration product. The applicants submit that the non-obviousness of the invention should be recognized.

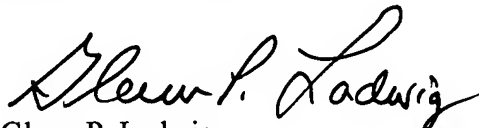
Accordingly, in view of the foregoing remarks, reconsideration and withdrawal of the rejections under 35 U.S.C. §103(a) is respectfully requested.

In view of the foregoing remarks, the applicants believe that the currently pending claims are in condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§1.16 or 1.17 as required by this paper to Deposit Account 19-0065.

The applicants invite the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephonic interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,



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Attachments: Request for Continued Examination

Petition and Fee for Extension of Time

Supplemental Information Disclosure Statement, Form PTO/SB/08, copy of reference